**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number

114944-00434

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or
printed
name _____

Application Number

10/698,943

Filed

November 3, 2003

First Named Inventor

Kelly Gravelle

Art Unit

2876

Examiner

Steve S. Paik

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s)

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/inventor
- ☐ Assignee of record of the entire interest
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)
- ☒ Attorney or agent of record
Registration number 35,126
- ☐ Attorney or agent acting under 37 CFR 1.34
Registration number if acting under 37 CFR 1.34

Signature

David J. Edmondson

Typed or printed name

202-772-5800

Telephone number

July 13, 2007

Date

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☒ *Total of 1 forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of)	
)	
Kelly GRAVELLE)	Art Unit 2876
)	
Patent Application No. 10/698,943)	Examiner: S. Paik
)	
Confirmation No. 5033)	Attorney Docket No.:
)	114944-00434
Filed November 3, 2003)	
)	Date: July 13, 2007
For: SELF-SERVICE ELECTRONIC TOLL)	
COLLECTION UNIT AND SYSTEM)	

STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In support of the Pre-Appeal Brief Request for Review filed concurrently herewith, the Applicant, through undersigned counsel, hereby makes the following statement.

The Applicant respectfully traverses the rejection of claims 1-49 and 51 under 35 U.S.C. § 103(a) over *Slavin et al.* in view of *Davis et al.* The present claims recite a vending unit and to recite that the payment acceptance device, dispenser, and processing device, among other components, are located in the vending unit. As discussed during the interview, such features are not taught or suggested in the applied prior art and would not have resulted from the combination of the applied references proposed in the Final Rejection.

The Applicant respectfully submits that the combination of references proposed in the Final Rejection would most likely have resulted in a system that sells transponder tags through a vending machine, in which the transponder tags have values predetermined at the factory. There would be no transmission of the stored value from the vending unit to a remote computer for maintaining account information regarding the electronic toll collection device, as in claim 1, nor would there be an administrative computer to which that stored value is transmitted, as in claim 15.

The replenishment of the transponder taught in Fig. 8 of *Slavin et al* happens after the transponder is sold and is thus irrelevant to the operation of the vending unit.

The accounting taught by *Davis et al* is not for the item sold through the vending machine, but instead for the card used to pay for the item. The card of *Davis et al* corresponds to the mode of payment for the transponder, not the transponder itself. As a consequence, the combination of references proposed in the Office Action would have resulted simply in a vending machine that accepts some sort of payment card to sell pre-packaged toll transponders with predetermined values, which is a far cry from the present claimed invention.

The Final Rejection includes a "Response to Arguments" section beginning on page 8. The Applicant will respond to each paragraph in turn.

Regarding the issue of whether there is any suggestion to combine the references, the Applicant's argument is not only that there is no such suggestion, but also that even if the references were combined, the result would not be the present claimed invention.

In the paragraph spanning pages 8 and 9 of the Final Rejection, it is alleged that it is obvious to combine the vending unit of *Davis et al* with the customer service center of

Slavin et al “to minimize operating cost of CSC by replacing an operator-assisted retail setting with a self-service vending unit.” However, that paragraph does not explain why it would have been obvious to a person having ordinary skill in the art *with no knowledge of the present claimed invention* to make such an incorporation. Instead, as explained above, a system according to the combination of references would simply have accepted some sort of payment card to sell pre-packaged toll transponders with predetermined values. The only teaching to do otherwise is found in the present invention itself.

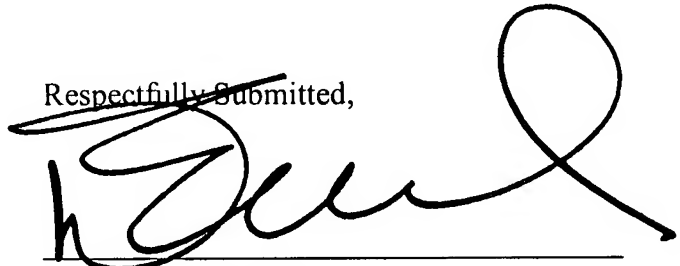
Finally, in the first full paragraph of page 9, the Final Rejection notes the argument that the replenishment of the transponder taught in *Slavin et al* happens after the transponder is sold and is thus irrelevant to the operation of the vending unit, but asserts that “the features upon which applicant relies are not recited in the rejected claim(s).” In response, the Applicant respectfully submits that the relevant features are recited in the claims and points to the following claim limitations to which the Applicant’s argument on that matter is relevant: the processing device, located in the vending unit, transmits the stored value from the vending unit to a remote computer for maintaining account information regarding the electronic toll collection device (claim 1); the processing device, located in the vending unit, transmits the stored value to the administrative computer for maintaining account information regarding the electronic toll collection device (claim 15); step (c) of automatically providing a stored value for the electronic toll collection device by transmitting the stored value from the vending unit to a remote computer for maintaining account information regarding the electronic toll collection device (claim 32); steps (a)-(d) of self-service maintenance of an account

through a vending unit (claim 45); and steps (a)-(d) of self-service checking of an account through a vending unit (claim 51).

For the reasons set forth above, the Applicant respectfully submits that the combination of references proposed in the Final Rejection would not have met all of the claim limitations. Withdrawal of the outstanding Final Rejection is therefore earnestly solicited.

Please charge any shortage of fees, or credit any overpayment thereof, to BLANK ROME LLP, Deposit Account No. 23-2185 (114944-00434). In the event that a petition for an extension of time is required to render this Amendment timely, and in the event that a separate petition either does not accompany this Amendment or is insufficient to render this Amendment timely, the Applicant hereby petitions under 37 C.F.R. § 1.136(a) for an extension of time for as many months as are required to render this Amendment timely. Any fee due is authorized above.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'D. Edmondson', written over a horizontal line.

David J. Edmondson
Registration No. 35,126

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